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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,156	01/26/2001	Adrian P. Wise	100413(EP)USC1X1C1D2 PDDD	8562
22887	7590	10/06/2004	EXAMINER VAUGHN JR, WILLIAM C	
DISCOVISION ASSOCIATES INTELLECTUAL PROPERTY DEVELOPMENT 2355 MAIN STREET, SUITE 200 IRVINE, CA 92614			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/770,156

Applicant(s)

WISE ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. This Action is in regards to the most recent papers received on 26 January 2001.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: The specification references multiple related patent applications. The current state of these applications, reflecting the status of present pendency, (i.e., abandonment or patent maturity), including associated patent numbers, should be amended into the specification.

Appropriate correction is required.

#### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Applicant claims domestic priority of U.S. Patent Application No. 08/382,952 in the original oath filed 26 January 2001, which is not the same as that of the mentioned U.S. Patent Application No. 08/382,958 in the disclosure (see page 2 of the specification).

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- a. Claim 4 recites the limitation "**the pipeline and the buffer**". There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 5, recites the limitation "the stages and the decoder". There is insufficient antecedent basis for this limitation in the claim.
- c. Claim 6 recites the limitation "the stages". There is insufficient antecedent basis for this limitation in the claim.
- d. Claim 8, recites the limitation "the buffer". There is insufficient antecedent basis for this limitation in the claim.
- e. Claim 9, recites the limitation "the buffer and the chip". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-3 and 8-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Horvath et al. (Horvath), U.S. Patent No. 5,540,599.
7. Regarding **claim 1**, Horvath discloses *an apparatus for processing tokens having variable length* [see Horvath, Col. 6, lines 17-29], *comprising: a padder to receive the tokens*

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*and to pad a portion of the tokens received by adding a tail which produces new tokens having integer numbers of data words of a predetermined length [see Horvath, Col. 4, lines 10-12]; and a storage buffer configured to store data words of the predetermined length and coupled to received the new tokens from the padder [see Horvath, Col. 8, lines 11-14, Col. 13, lines 7-18].*

By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Horvath discloses *wherein two types of the new tokens have two different numbers of words* [see Horvath, Col. 6, lines 17-29]. By this rationale **claim 2** is rejected.

9. Regarding **claim 3**, Horvath discloses *wherein different data tokens may have different numbers of data words* (Horvath teaches variable length words), [see Horvath, Col. 6, lines 17-29]. By this rationale claim 3 is rejected.

10. Regarding **claim 8**, Horvath discloses *a start code detector, the buffer being located in the start code detector* [see Horvath, Col. 3, lines 30-61]. By this rationale **claim 8** is rejected.

11. Regarding **claim 9**, Horvath discloses *a semiconductor chip, the padder being located on the chip* [see Horvath, Col. 33-48]. By this rationale **claim 9** is rejected.

12. Regarding **claim 10**, Horvath discloses *wherein the padder is a hardware device* [see Horvath, Col. 1, lines 33-42]. By this rationale **claim 10** is rejected.

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13. Regarding **claim 11**, Horvath discloses *a Huffman decoder coupled to receive the tokens from the padder* [see Horvath, Col. 6, lines 10-29]; *a token formatter coupled to receive data from the Huffman decoder* [see Horvath, Figure 4]; *and an inverse modeler coupled to receive data from the token formatter* [see Horvath, Figure 4, Col. 7, lines 7-13, Col. 9, lines 55-67 and Col. 10, lines 1-9]. By this rationale **claim 11** is rejected.

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14. **Claims 12-22** contains similar limitations corresponding to the apparatus claimed in claims 1-3 and 8-11; therefore claims 12-22 are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 4, 5, 6, and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvath in view of Ueda et al. (Ueda), U.S. Patent No. 5,148,529.

17. Regarding **claim 4**, Horvath discloses the invention substantially as claimed. Eventhough, Horvath does imply the use of a sequential pipeline processing for the compression and decompression of image data. Horvath discloses a two-wire interface coupling the pipeline to an output of the buffer [see Horvath, Figure 1]. Eventhough, Horvath does imply sequential pipelined processing. However, Horvath does not explicitly disclose the details of it be a multi-stage pipelined decoder.

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18. In the same field of endeavor, Ueda discloses (e.g., pipelined multi-stage data processor including an operand bypass mechanism). Ueda discloses *a multi-stage pipelined decoder* [see Ueda, abstract, Col. 6, lines 45-62].

19. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Ueda's teachings of a pipelined multi-stage data processor including an operand bypass mechanism with the teachings of Horvath, for

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allowing the system to perform on different standards without adding additional hardware. By this rationale **claim 4** is rejected.

20. Regarding **claim 5**, Horvath-Ueda discloses *wherein a portion of the stages of the decoder are reconfigurable to decode video data by a portion of the tokens* [see Horvath, Col. 40-47]. By this rationale **claim 5** is rejected.

21. Regarding claim 6, Horvath-Ueda discloses *wherein configurations of the stages are responsive to standards by which data in the portion of the tokens is formatted* [see Horvath, Col. 1, lines 33-51]. By this rationale **claim 6** is rejected.

22. Regarding **claim 7**, Horvath-Ueda discloses *wherein the standards include two of MPEG, JPEG, and H.261* [see Horvath, Col. 1, lines 33-41]. By this rationale **claim 7** is rejected.

### ***Double Patenting***

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,330,666. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

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subject matter discloses in the application is substantially the same as that of the U.S. Patent No. 6,330,666.

25.

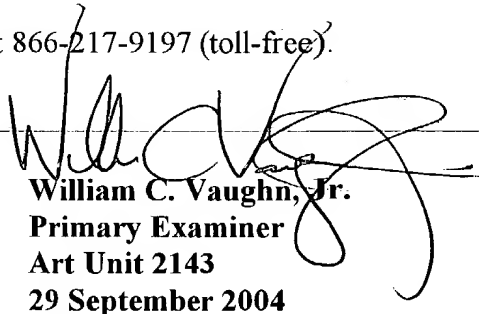
*Conclusion*

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**William C. Vaughn, Jr.**  
**Primary Examiner**  
**Art Unit 2143**  
**29 September 2004**